



Docket No.: 13735US2/(C38435/109700)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
A. ASAKURA

Serial No.: 09/470,667

Filed: December 22, 1999

For: **NOVEL ALCOHOL/ALDEHYDE
DEHYDROGENASE**

)
) Examiner: Unassigned
) Art Unit: 1633
)

RECEIVED
00 MAY 21 PM 2:27

New York, New York
May 19, 2000

**RESPONSE TO NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT
APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID
SEQUENCE DISCLOSURES**

Assistant Commissioner for Patents
Box Non-Fee Amendment
Washington, DC 20231

Sir:

This is in response to the NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES ("Notice") mailed February 3, 2000 (copy enclosed as Exhibit 1). No fee is believed to be due. If it is determined that a fee is due, please charge such fee to Deposit Account No. 02-4467. A duplicate copy of this sheet is enclosed.

The Notice asserts that "a copy of the Sequence Listing in computer readable form has not been submitted as required by 37 CFR §1.821(e)." For the reasons set forth below, withdrawal of the Notice, respectfully is solicited.

In a teleconference between Nicole Maddaloni of our offices and Examiner Robert Wax on May 16, 2000, Examiner Wax acknowledged that the Notice was issued in error

#3

and instructed us to respond to the Notice by enclosing a copy of the Request to Transfer the Previously Filed Sequence Information Pursuant to 37 CFR §1.821(e) ("Request") filed on December 22, 1999 (copy enclosed as Exhibit 2) with the present application. Examiner Wax also advised that no extension of time fee is due because the Notice was issued in error by the U.S. Patent and Trademark Office.

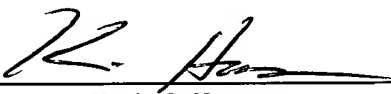
The present application is a continuation of U.S. patent application serial no. 08/934,506 (" '506 application"). The application transmittal papers of the present application including the above-identified Request, a Certificate of Express Mailing, and a post card (copies enclosed as Exhibit 3) were filed with the U.S. Patent and Trademark Office by Express Mail, Post Office to Addressee service. 37 CFR §§1.6(a)(2) and 1.10. The post card was returned with a date stamp which is *prima facie* evidence of receipt by the U.S. Patent Office of the filing materials, including the Request. MPEP §503.

The Request filed on December 22, 1999, properly identified the '506 application and the computer readable form from that application to be transferred to the present application pursuant to 37 CFR §1.821(e). Thus, as Examiner Wax advised, the Notice was issued in error and must be withdrawn.

#3


In view of the foregoing, withdrawal of the Notice, respectfully is solicited. If the Examiner has any questions regarding this paper, please contact the undersigned attorney.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231, on May 19, 2000.



Kevin C. Hooper

Respectfully submitted,

By: 

Kevin C. Hooper
Registration No. 40,402
BRYAN CAVE LLP
245 Park Avenue
New York, NY 10167-0034
(212) 692-1800



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARK
Washington, D.C. 20231

#3

APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO./TITLE
09/470,667	12/22/99	ASAKURA	A 13735 (109700)

0232/0203

MARK E WADDELL ESQ
BRYAN CAVE LLP
245 PARK AVENUE
NEW YORK NY 10167-0034

1633

DATE MAILED:

2 month

02/03/00

Due Date 4-3-2000

Statutory Date 8-3-2000

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS
CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

An Application Number and Filing Date have been assigned to this application. The items indicated below, however, are missing. Applicant is given TWO MONTHS FROM THE DATE OF THIS NOTICE within which to file a sequence listing in compliance with 37 CFR 1.821 - 1.825 to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821 - 1.825 for the following reason(s):

- ☐ 1. This application fails to comply with the requirements of 37 CFR 1.821 - 1.825.
- ☐ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 CFR 1.821(c).
- ☒ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. The content of the computer readable form, however, does not comply with the requirements of 37 CFR 1.822 and/or 1.832, as indicated on the attached marked-up copy of the "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as required by 37 CFR 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 CFR 1.821(e).
- ☐ 7. OTHER: _____

APPLICANT MUST PROVIDE:

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing."
- ☐ An initial or substitute paper copy of the "Sequence Listing," as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b) or 1.825(d).

FOR QUESTIONS REGARDING COMPLIANCE WITH THESE REQUIREMENTS, PLEASE CONTACT:

- ☐ For Rules Interpretation, call (703) 308-1123.
- ☐ For CRF submission help, call (703) 308-4212.
- ☐ For PatentIn software help, call (703) 308-6856.

Customer Service Center
Initial Patent Examination Division (703) 308-1202

DOCKETED

DATE 2-8-2000

INITIAL



Express Mail Label No.: EM036754095US
Docket No.: 13735 (109700/C38435)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Rule 1.53(b) Continuing Application of:

AKIRA ASAKURA, TATSUO HOSHINO, SETSUKO OJIMA,
MASAKO SHINJOH and NORIBUMI TOMIYAMA

Parent Serial No.: 08/934,506

Parent Filed: September 19, 1997

For: **NOVEL ALCOHOL ALDEHYDE
DEHYDROGENASE**

)
) Parent Examiner: E. Stole

)
) Parent Art Unit: 1653

)
)
New York, New York
December 22, 1999

**REQUEST TO TRANSFER PREVIOUSLY FILED SEQUENCE
INFORMATION PURSUANT TO 37 CFR § 1.821(e)**

Assistant Commissioner for Patents
Box Patent Application
Washington, D.C. 20231

Sir:

In accordance with 37 CFR 1.821(e), please use the last-filed computer readable form of the Sequence Listing in co-pending U.S. Application Serial Number 08/934,506, filed September 19, 1997 to which the present application claims priority as a continuation as the computer readable form for the instant application.

It is understood that the Patent and Trademark Office will make the necessary change in application number and filing date for the instant application. A paper copy of the Sequence Listing is included with the application filed concurrently herewith for incorporation into the specification.

Respectfully submitted,

By: 

Timothy E. Tracy
Registration No. 39,401
BRYAN CAVE LLP
245 Park Avenue
New York, NY 10167-0034
(212) 692-1800



Express Mail No.: EM036754095US
Docket No.: 13735 (109700/C38435)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Rule 1.53(b) Continuing Application of:
AKIRA ASAKURA, TATSUO HOSHINO, SETSUKO OJIMA,
MASAKO SHINJOH and NORIBUMI TOMIYAMA

)
) Parent Examiner: E. Stole

Parent Serial No.: 08/934,506

) Parent Art Unit: 1653

Parent Filed: September 19, 1997

)

For: **NOVEL ALCOHOL ALDEHYDE
DEHYDROGENASE**

)

New York, New York
December 22, 1999

REQUEST FOR FILING A RULE 1.53(b) CONTINUING APPLICATION

BOX PATENT APPLICATION
Assistant Commissioner for Patents
Washington, D. C. 20231

Sir:

This is a request for filing a continuation application under 37 CFR Section 1.53(b), of prior pending U.S. Application Serial No. 08/934,506, filed September 19, 1997.

1. [x] A copy of the prior application as originally filed in the parent case is enclosed. The undersigned hereby verifies that the enclosed application is a true copy of the parent application as originally filed. (See paragraph 2 regarding any amendments filed in the parent case to "complete" that application. See paragraphs 11 and 12 regarding drawings and/or Sequence Listing, if any.)
2. [] Copies of amendments filed ___ and ___ to "complete" the parent application are enclosed. The undersigned hereby verifies that enclosed copies of the amendments are true copies of the amendments as originally filed in the parent case and that the amendments did not introduce impermissible new matter into that application.

3. ☒ The filing fee is calculated below on the basis of the claims in the parent application as originally filed plus or minus any claims added or canceled by amendment:

Claims as Filed, Plus/Minus Any Claims Added/Canceled By Amendment

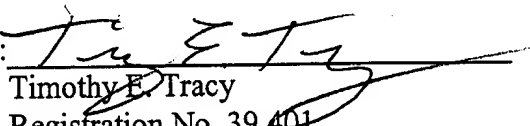
For	Number Filed	Number Extra	Rate	Basic Fee = \$	760.00
Total claims	28-20=	8	x \$18 =	\$	144.00
Independent claims	6-3=	3	x \$78 =	\$	18.00
Total Filing Fees				\$	922.00

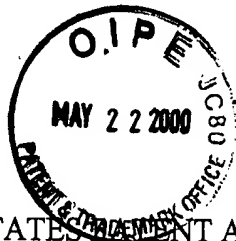
- a. ☒ A check in the amount of \$922 to cover the filing fee is enclosed. If our check is missing or otherwise insufficient, or if any additional fees are required, please charge (or credit any overpayment) to Deposit Account No. 02-4467. A duplicate copy of this paper is enclosed.
- b. ☐ Please charge Deposit Account No. 02-4467 in the amount of \$ _____. A duplicate copy of this paper is enclosed.
4. ☒ For this continuation application and the parent application the Commissioner is hereby authorized to charge payment of the following fees, or to credit any overpayment, to Deposit Account No. 02-4467. A duplicate copy of this paper is enclosed.
- a. ☒ Any additional filing fees required under 37 CFR Section 1.16 not otherwise paid by check.
- b. ☒ Any patent application processing fees required under 37 CFR Section 1.17 not otherwise paid by check.
- c. ☒ Any additional Assignment recording fees under 37 CFR Section 1.21 (h) not otherwise paid by check.
5. ☒ Amend the specification by inserting before the first line, the sentence: - - This is a continuation of U.S. Application Serial No. 08/934,506, filed September 19, 1997. - -
6. ☐ Please cancel claims __ and __ as originally filed before calculating the filing fee.
7. ☐ A Preliminary Amendment is enclosed. Please enter it before calculating the filing fee.
8. ☒ The prior application is assigned of record to ROCHE VITAMINS INC.

9. ☐ The prior application is not assigned. An assignment to _____, a Recordation Form Cover Sheet, and a check for \$_____ to cover the recording fee are enclosed. If our check is missing or otherwise insufficient, or if any additional fees are required, please charge (or credit any overpayment) to Deposit Account No. 02-4467.
10. ☒ Address all communications to:
- Mark E. Waddell, Esq.
BRYAN CAVE LLP
245 Park Avenue
New York, New York 10167-0034
tel. (212) 692-1800
fax (212) 692-1900
11. ☒ Drawings are part of this continuing application.
- a. ☐ Transfer the drawings from the parent application to this Rule 1.53(b) application and abandon the parent application as of the filing date accorded this application. A duplicate copy of this paper is enclosed for filing in the parent case. (May be used only if the undersigned is one authorized by 37 CFR Section 1.138 and before payment of the issue fee in the parent case.)
- b. ☐ New formal drawings are enclosed.
- c. ☒ Informal drawings are enclosed. The undersigned hereby verifies that these drawings are true copies of the drawings in the parent application as originally filed.
12. ☒ A Sequence Listing is part of this continuing application.
- a. ☐ A Sequence Listing in both paper and computer readable form (diskette) as required by 37 CFR 1.821 et seq. is enclosed.
- b. ☐ A statement that the content of the paper and computer readable Sequence Listing are the same and that no new matter has been added is enclosed, pursuant to 37 CFR §§1.821(f) and (g).
- c. ☒ A request to transfer previously filed sequence information pursuant to 37 CFR § 1.821(e) is enclosed.
14. ☒ Priority is hereby claimed under 35 USC Section 119 based on Appln. No. 96115001.8, filed September 19, 1996, in Europe.
- a. ☒ Certified copies of the priority document(s) is(are) already of record in U.S. Application Serial No. 08/934,506, filed September 19, 1997.

- b. ☐ The certified priority document(s) is(are) enclosed herewith for filing in this continuing case.
- c. ☐ Certified copies of the priority document(s) will follow.
15. ☒ The current power of attorney is to George W. Johnston, Reg. No. 28,090; William H. Epstein, Reg. No. 20,008; Dennis P. Tramaloni, Reg. No. 28,542; Lewis J. Kreisler, Reg. No. 38,522; Patricia S. Rocha-Tramaloni, Reg. No. 31,054; and Briana C. Buchholz, Reg. No. 39,123. The power is of record in U.S. Application Serial No. 08/934,506, filed September 19, 1997.
16. ☐ A Power of Attorney to Associate Attorney is of record in U.S. Application Serial No. ___, filed ___. The associate power of attorney is to Mark E. Waddell, Reg. No. 31,803; Stephen M. Haracz, Reg. No. 33,397; Warren MacRae, Reg. No. 37,876; Timothy E. Tracy, Reg. No. 39,401; Kevin C. Hooper, Reg. No. 40,402; Kathleen Gersh, Reg. No. 41,806; Leo G. Lenna, Reg. No. 42,796; and Robert J. Lipka, Reg. No. 42,807. A copy of the Power of Attorney to Associate Attorney enclosed.
17. ☒ A petition for extension of time in the parent application is enclosed so that the parent application will be pending as of the time this paper is filed.
18. ☒ The undersigned declares that all statements made herein of his or her own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

By: 
Timothy E. Tracy
Registration No. 39,401
BRYAN CAVE LLP
245 Park Avenue
New York, New York 10167-0034
(212) 692-1800



Docket No.: 13735 (109700/C38435)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Rule 1.53(b) Continuing Application of :

AKIRA ASAKURA, TATSUO HOSHINO, SETSUKO OJIMA,
MASAKO SHINJOH and NORIBUMI TOMIYAMA

)
) Parent Examiner: E. Stole

Serial No.: not yet assigned

)
) Parent Art Unit: 1653

Filed: concurrently herewith on December 22, 1999

For: **NOVEL ALCOHOL ALDEHYDE
DEHYDROGENASE**

CERTIFICATE OF EXPRESS MAILING

"Express Mail" Mailing Label No.: EM036754095US

Date of Deposit: December 22, 1999

I hereby certify that the following:

- [x] This Certificate of Express Mailing
- [x] Request for Filing a Rule 1.53(b) Continuing Application (4 pp. in duplicate)
- [x] Copy of the prior application as originally filed in the parent case (94 pp. including specification, claims and abstract)
- [x] 9 sheets of drawings
- [x] Request to Transfer Previously Filed Sequence Information Pursuant to 37 CFR § 1.821(e) (1 pg.)
- [x] Check in the amount of \$922 to cover filing fee
- [x] Request for 3-Month Extension of Time in the parent case (1 pg. in duplicate)
- [x] Check in the amount of \$870 to cover extension fee
- [x] Return postcard

are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR Section 1.10 on the Date of Deposit indicated above in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Gregory Smalls

Signature of Person Making Deposit

BRYAN CAVE LLP
245 Park Avenue
New York, New York 10167-0034
212/692-1800



C38435/109700

December 22, 1999

In re Rule 1.53(b) Continuing Application of AKIRA ASAKURA
et al.

Serial No. not assigned

Filed: concurrently

For: NOVEL ALCOHOL ALDEHYDE DEHYDROGENASE

Enclosed:

1. Certificate of Express Mailing Label No. EM036754095US
2. Request for Filing a Rule 1.53(b) Continuing Application (4 pp. in duplicate)
3. Copy of prior application as originally filed (94 pp.)
4. 9 sheets of drawings
5. Request to Transfer Previously Filed Sequence Information Pursuant to 37 CFR
§ 1.821(e) (1 pg.)
6. Check in the amount of \$922 to cover filing fee
7. Request for 3-Month Extension of Time in the parent case (1 pg. in duplicate)
8. Check in the amount of \$870 to cover extension fee
9. Return postcard



**PLEASE DATE STAMP AND RETURN
TO ACKNOWLEDGE RECEIPT**

233843.01 TET/mu